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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,398	04/30/2005	Charles C. Hart	2395-USP-PCT-US	9071
21378	7590	05/29/2008	EXAMINER	
APPLIED MEDICAL RESOURCES CORPORATION			NEAL, TIMOTHY J	
22872 Avenida Empresa			ART UNIT	PAPER NUMBER
Rancho Santa Margarita, CA 92688			3731	
MAIL DATE		DELIVERY MODE		
05/29/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/533,398	HART, CHARLES C.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Timothy J. Neal	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 November 2007.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 and 39-60 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 39-43 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 22-28, 44-60 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/07/08</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

This action is in response to the amendments received on 11/16/2007.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 22-28 and 44-60** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner does not consider the original filing to adequately describe the jaws ability to be completely positioned within the elongate shaft. Figures 5A, 5B, 8, 12A, 12B, and 15A-15C show the device with the elongate shaft or a trocar. None of these pictures definitively show the jaws being positioned within the elongate shaft. The size of the shaft in figures 12A and 12B suggest that the jaws would fit within the shaft, but that is not sufficient for the claim amendments. It is not clear that the device is designed to operate in a manner that will allow the jaws to be removed from the shaft or even be in the shaft in the first place. The jaws are not slidably connected to the shaft so it is not clear how the jaws would start within the shaft and then extend from the shaft. The sliding member 625 is

described as advancing a securing member, not the jaws. Therefore, there is no description that would enable one of ordinary skill to operate the device as claimed.

**Claims 22-28 and 44-60** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As stated above with the new matter, there is no description that clearly conveys to one having ordinary skill in the art how the jaws and elongate shaft would operate.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 22-28, 44-48, and 50-60** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hart et al. (US 6,139,555).

Hart '555 discloses a pair of jaws (30), a handle (50 and 52), a sliding member (56), and slots in the jaws (38). The other claims are considered functional and Column 2 Line 22 supports the Examiner's position that the Hart device is capable of performing these operations. The Examiner considers the use of a trocar as obvious. The trocar is

thus considered the elongate shaft and the jaws can be positioned within the shaft completely. The use of a trocar facilitates entry of the device into the patient.

Hart '555 does not specifically disclose the claimed shape of the sliding member. The Examiner considers the modification of the shape of the sliding member to be within the purview of one having ordinary skill in the art. Hart's device includes a cylindrical sliding member. The claimed rectangular shape, although not stated by the Applicant, is simply designed to engage both jaw members. The Examiner also notes that other than providing necessary function, for example the sliding member should be shaped so that engages both jaws and not only one jaw, there is no particular advantage to the design. Therefore, the Examiner considers the claimed shapes to be obvious to a person having ordinary skill in the art at the time the invention was made and would be incorporated into Hart's applier in a predictable manner.

**Claim 49** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hart et al. (US 6,139,555) in view of Hart et al. (US 6,258,105).

Hart '555 discloses the invention substantially as claimed as stated above. Hart does not disclose the shape of the jaw members as claimed. Hart '105 discloses jaws (30) and a sliding member (58) in which the jaws have a width larger than their height and a height less than the height of the sliding member (figures 1-7). Hart '105 is relied on mostly as a reference to show that the relative size of jaws to sliding members as claimed is not novel. As stated above in regards to the claimed shape of the sliding member, the claimed shape of the jaws is not disclosed as being critical. Again, the

modification of shape is within the purview of one having ordinary skill in the art. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Hart's jaw structure to include the claimed structure as shown in Hart '105. Generally, modifying jaw structure in a clip applier is done so that the jaws will be shaped to work with the particular clips being used in the procedure.

### ***Response to Arguments***

Applicant's arguments filed 11/16/2007 have been fully considered but they are not persuasive.

The Applicant has included features that the Examiner does not consider inherent or fully described in the original filing. The jaws are not shown or described as being configured to be positioned within the elongate shaft. The elongate shaft is shown as item 155 and 605. No figure shows the jaws within the shaft. Several figures (Figure 8 and Figures 15A-15C) show the jaws closed while in a trocar. The trocar is not described as being the same item as the elongate shaft. It is actually shown as a different item in figures 8 and 15A-15C. The claims do say that the jaws are connected to the elongate member. There is no discussion of this connection as being slidable. For these reasons, the Examiner considers the new limitations to include new matter and to not be enabled by the original filing. The Examiner has therefore rejected the claims using a trocar as the elongate shaft. Trocars are well known and would be obvious to use in an operation of this type.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Neal whose telephone number is (571) 272-0625. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LoAn Thanh can be reached on (571) 272-4966. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TJN  
/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3731